

Neifeld Docket No: INVE0012-1

Application/Patent No: 09/251,480 7,958,224

USPTO CONFIRMATION NO: 3291

File/Issue Date: 2/17/1999 6/7/2011

Inventor/Title: Amjadi/Incentive Network

Examiner/ArtUnit: Dinh/2451

ENTITY STATUS: LARGE

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 1.701 APPLICATION FOR PATENT TERM EXTENSION

I. Statement of the Precise Relief Requested

The patentee requests that the Director change the extension of patent term under 37 CFR 1.701 to 1165 days.

II. Material Facts in Support of the Petition

1. The Director determined a patent adjustment of 876 days, under 35 USC 154 (b), as noted on the issue notification dated May 18, 2011.

2. 35 USC 154 (b) applies to patents filed on or after May 29, 2000.

3. The subject application was filed February 17, 1999, therefore 37 CFR 1.701, which covers applications filed on or after June 8, 1995 and before May 29, 2000, is applicable to determine patent term extension.

4. 37 CFR 1.701 (a)(3) states in pertinent part: (a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to: Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent

claiming subject matter that is not patentably distinct from that under appellate review.

5. 37 CFR 1.701 (b) states: "The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent."

5A. 37 CFR 1.701(d) states "(d)The period of delay set forth in paragraph (c)(3) shall be reduced by: ... (2)Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. "

5B. 37 CFR 1.704(b) states that "an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant".

USPTO DELAY

6. On March 19, 2007, the applicant filed a notice of appeal.
7. On August 27, 2010, the USPTO mailed a BPAI decision on appeal, reversing the rejections.
8. The total USPTO delay spans March 19, 2007 through August 27, 2010; and the total USPTO delay is 1257 days.

APPLICANT DELAY

9. On May 14, 2007, the USPTO mailed a pre-brief appeal conference decision.
10. On November 14, 2007, the applicant filed an appeal brief.
11. The total applicant delay spans August 14, 2007 through November 14, 2007, which is 92 days.

III. Reasons Why the Relief Requested Should be Granted

The term extension applicable under 37 CFR 1.701 is calculated as follows:

12. 37 CFR 1.701 (b) states: "The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent."

13. 37 CFR 1.701 (c)(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

14. **As noted in facts 6-8 above, as applied to facts 12 and 13 above, the total USPTO delay is 1257 days.**

15. The net USPTO delay is 1257 days less 92 days, or 1165 days. The applicant is entitled to 1169 days of patent term extension under 37 CFR 1.701.

16. Exhibit 1 attached hereto is an image of the Transaction History tab of PAIR for this application, showing the dates noted herein above.

IV. Conclusion

The net patent term extension is 1165 days.

V. Fee under 37 CFR 1.18(e)

An EFS credit card authorization in the amount of \$200 is submitted herewith to cover the fee for filing an application for the patent term adjustment.

Respectfully submitted,

/BruceMargulies/

BRUCE MARGULIES

Date 6/23/2011

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Reg. No. 64,175 Attorney of Record

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03-12-2009 Information Disclosure Statement (IDS) Filed
 04-09-2002 Order Recurring Undocketed Appeal to the Examiner
 03-12-2009 Information Disclosure Statement (IDS) Filed
 02-18-2009 Appeal Awaiting BPAI Docketing
 02-10-2009 Appeal ready for BPAI review
 11-07-2008 Appeal ready for BPAI docketing
 10-22-2008 Mail Miscellaneous Communication to Applicant
 10-21-2008 Miscellaneous Communication to Applicant - No Action Count
 10-06-2008 Case Docketed to Examiner in GAU
 09-09-2008 Return of Undocketed appeal to the TC
 09-09-2008 Exam. Ans. Review Complete
 08-21-2008 Mail Examiner's Answer
 08-18-2008 Examiner's Answer to Appeal Brief
 08-18-2008 Date Forwarded to Examiner
 11-14-2007 Appeal Brief Filed
 08-19-2008 Mail of Withdraw of Informal Amendment Notice
 08-18-2008 Withdraw of Informal Amendment Notice
 03-31-2008 Mail Examiner Interview Summary (PTOL - 413)
 03-20-2008 Examiner Interview Summary Record (PTOL - 413)
 01-20-2008 Notice -- Defective Appeal Brief
 11-27-2007 Appeal Brief Review Complete
 11-27-2007 Date Forwarded to Examiner
 11-14-2007 Defective / Incomplete Appeal Brief Filed
 11-14-2007 Appeal Brief Filed
 11-28-2007 Mail Notice of Rescinded Abandonment
 11-27-2007 Notice of Rescinded Abandonment in TCs
 11-09-2007 Mail-Petition to Revive Application - Granted
 11-09-2007 Petition to Revive Application - Granted
 11-09-2007 Petition Entered
 10-09-2007 Mail Abandonment for Failure to Respond to Office Action
 10-01-2007 Aband. for Failure to Respond to Office Action
 05-14-2007 Mail Appeals conf. Proceed to BPAI
 05-10-2007 Pre-Appeals Conference Decision - Proceed to BPAI
 03-19-2007 Request for Pre-Appeal Conference Filed
 03-19-2007 Notice of Appeal Filed
 03-19-2007 Request for Extension of Time - Granted
 11-17-2006 Mail Non-Final Rejection
 11-13-2006 Non-Final Rejection
 09-05-2006 Date Forwarded to Examiner
 08-24-2006 Appeal Brief Filed
 08-24-2006 Request for Extension of Time - Granted
 08-02-2006 Notice -- Defective Appeal Brief
 07-31-2006 Appeal Brief Review Complete
 07-31-2006 Date Forwarded to Examiner
 07-03-2006 Defective / Incomplete Appeal Brief Filed
 07-03-2006 Appeal Brief Filed
 07-03-2006 Request for Extension of Time - Granted
 03-02-2006 Mail Appeals Conf. Proceed to BPAI
 02-28-2006 Pre-Appeals Conference Decision - Proceed to BPAI
 01-09-2006 Request for Pre-Appeal Conference Filed
 01-11-2006 Notice of Appeal Filed
 01-11-2006 Request for Extension of Time - Granted
 10-06-2005 Mail Final Rejection (PTOL - 326)
 10-03-2005 Final Rejection
 07-29-2005 Date Forwarded to Examiner
 07-22-2005 Response after Non-Final Action
 04-22-2005 Mail Non-Final Rejection
 04-18-2005 Non-Final Rejection
 04-13-2005 Correspondence Address Change
 02-13-2005 IFW TSG Processing by Tech Center Complete
 02-13-2005 Date Forwarded to Examiner
 02-13-2005 Date Forwarded to Examiner
 01-28-2005 Request for Continued Examination (RCE)
 02-12-2005 Disposal for a RCE / CPA / R129
 01-28-2005 Reference capture on IDS
 01-28-2005 Information Disclosure Statement (IDS) Filed
 01-28-2005 Information Disclosure Statement (IDS) Filed
 07-12-1999 Oath or Declaration Filed (Including Supplemental)
 01-28-2005 Workflow incoming amendment IFW
 01-28-2005 Workflow - Request for RCE - Begin
 07-28-2004 Mail Final Rejection (PTOL - 326)
 07-26-2004 Final Rejection
 07-26-2004 Case Docketed to Examiner in GAU

05-04-2004 Date Forwarded to Examiner
 04-22-2004 Response after Non-Final Action
 04-22-2004 Request for Extension of Time - Granted
 04-22-2004 Workflow incoming amendment IFW
 10-23-2003 Mail Non-Final Rejection
 10-17-2003 Non-Final Rejection
 10-09-2003 Date Forwarded to Examiner
 10-09-2003 Date Forwarded to Examiner
 09-30-2003 Request for Continued Examination (RCE)
 10-09-2003 Disposal for a RCE / CPA / R129
 09-30-2003 Workflow - Request for RCE - Begin
 09-30-2003 Mail Final Rejection (PTOL - 326)
 06-27-2003 Final Rejection
 04-22-2003 Date Forwarded to Examiner
 04-15-2003 Response after Non-Final Action
 04-15-2003 Request for Extension of Time - Granted
 11-15-2002 Mail Non-Final Rejection
 11-14-2002 Non-Final Rejection
 09-13-2002 Date Forwarded to Examiner
 08-28-2002 Continuing Prosecution Application - Continuation (A/CPA)
 09-13-2002 Disposal for a RCE / CPA / R129
 08-28-2002 Request for Extension of Time - Granted
 09-11-2002 Main-Petition to Revive Application - Granted
 08-28-2002 Petition Entered
 08-28-2002 Workflow - Request for CPA - Begin
 06-10-2002 Correspondence Address Change
 06-11-2002 Change in Power of Attorney (May Include Associate POA)
 11-26-2001 Correspondence Address Change
 05-29-2001 Main-Petition Decision - Denied
 05-23-2001 Petition Entered
 05-22-2001 Mail Non-Final Rejection
 05-18-2001 Non-Final Rejection
 03-28-2001 Case Checked to Examiner in GAU
 07-16-1999 Information Disclosure Statement (IDS) Filed
 07-16-1999 Information Disclosure Statement (IDS) Filed
 10-15-1999 Case Checked to Examiner in GAU
 08-18-1999 Information Disclosure Statement (IDS) Filed
 08-18-1999 Information Disclosure Statement (IDS) Filed
 08-11-1999 Information Disclosure Statement (IDS) Filed
 08-11-1999 Information Disclosure Statement (IDS) Filed
 07-27-1999 Application Dispatched from OIPE
 07-16-1999 Application is Now Complete
 03-10-1999 Notice Mailed--Application Incomplete--Filing Date Assigned
 03-04-1999 IFW Scan & PACR Auto Security Review
 02-23-1999 Initial Exam Team run

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- Send general questions about USPTO programs to the [USPTO Contact Center \(USPTO-CC\)](mailto:USPTO.Contact.Center@USPTO.gov).
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